

Application No.: 09/050,808
Reply Brief Dated: October 23, 2007
Reply to Office Action of: August 23, 2007

MAT-5860US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/050,808
Appellant: Yutaka Machida
Filed: March 30, 1998
Title: DECODING AND CODING METHOD OF MOVING IMAGE SIGNAL, AND
DECODING AND CODING APPARATUS OF MOVING IMAGE SIGNAL USING
THE SAME
TC/A.U.: 2621
Examiner: Allen C. Wong
Confirmation No.: 7277
Docket No.: MAT-5860

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner continues to argue that claims 21 and 22 are non-enabling - hence the rejection under 35 U.S.C § 112, 1st paragraph. The basis for the rejection is "that the term N-M" can be equal a number zero or a negative number. The Examiner now takes the position that "There is no such thing as a negative number block or negative number frame in the field of decoding blocks of frames." Appellant's representative wishes to refer to the two illustrations which appears on page 5 of the Appeal Brief. One of "ordinary skill of the art" would have absolutely no problem understanding the illustrations if negative numbers were used.

Even assuming the Examiner is correct (and Appellant's representative maintains that he is not) Chisum § 7.03(7)(c) cites several cases that disagree with the Examiner's position:

Claims are addressed to the person of average skill in the particular art. Compliance with 112 must be adjudged from that perspective, not in a vacuum. It is always possible to theorize some combination of circumstances which would render a claims composition or method inoperative, but the art-skilled would assuredly not choose such a combination. Ex part Cole, 223 USPQ 94, 95-96 (PTO BD.APP 1983).

Regarding Appellant's argument that there is no statutory requirement for a specification to mention the "specific terms" in the specification relevant to the claims, the Examiner's

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position is that "the Examiner respectfully disagrees." There is a plethora of case law that contradicts the Examiner's position:

The prior application need not describe the claimed subject matter in exactly the same terms as used in the claims, *University of Rochester v. G.D. Searle & Co., Inc.* 358 F.3d 916, 922-23 (Fed. Cir. 2004);

This court and its predecessor have repeatedly held that claimed subject matter 'need not be described in haec verba' in the specification to satisfy the written description requirement, e.g., *In re Smith*, 481 F.2d 910,914 (CCPA 1973)"); *Cordis Corp. v. Medtronic Ave, Inc.*, 339 F.3d 1352,1364,67 USPQ2d 1876 (Fed. Cir. 2003);

In order to comply with the written description requirement, the specification 'need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claims.' *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995);

The failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows have been invented. *Crown Operations International, Ltd. V. Solutia Inc.*, 289 F.3d 1367, 1376, 62 USPS2d 1917 (Fed. Cir. 2002)

In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide in haec verba support for the claimed subject matter at issue, *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000)

Regarding the prior art rejection, page 8 of the Examiner's answer, line 5, states that the Examiner will consider the claimed feature "corresponding locations in accordance with MPEG standards." The Examiner's position is not understood because there have been no MPEG standards that have been made of record in the file wrapper. Thus, the definition being used the Examiner is unclear.


Appellant's representative previously made arguments regarding the fact that Appellant's claims 21 and 22 include specific language setting forth that Appellant's error

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correction is occurring across different frames (i.e. "frame N" "frame N-M."). Appellant previously argued that the Yamaguchi reference which was cited against Appellant's claims does not perform error correction in different frames. The Examiner's answer does not respond to Appellant's position.

Respectfully submitted,



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